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Attorney Docket No.47777-0005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Christian MAYAUD

Serial No.

09/941,681

Filing Date

August 30, 2001

Title

A COMPUTERIZED PRESCRIPTION SYSTEM FOR

GATHERING AND PRESENTING INFORMATION

RELATING TO PHARMACEUTICALS

Examiner

Samuel G. Rimell

Group/Art Unit

2165

Commissioner for Patents Alexandria, VA 22313-1450

DECLARATION OF ASSIGNEE IN SUPPORT OF SUBMISSION OF 37 C.F.R. § 1.131 DECLARATION FOR A NON-COOPERATIVE INVENTOR

I, Ted W. Whitlock, declare and state as follows:

- I am intellectual property counsel for Andrx Corporation, the parent corporation
 of and owner of Cybear, LLC. I am a Registered Patent Attorney, Registration
 No. 36,965. Cybear, LLC is the Assignee of the above captioned patent
 application (the '681 Application).
- 2. I am familiar with the prosecution of the '681 Application. I have met with and communicated with the named inventor Christian Mayaud, regarding his submission of facts and documents supporting his conception and diligence for the '681 Application.

- 3. On January 22, 2004, a 37 C.F.R. section 1.131 declaration executed by the inventor, Christian Mayaud, was filed (mail room date January 22, 2004) for the purpose of swearing behind a reference, Schrier, et al., U.S. Patent No. 5,833,599. On June 7, 2004, a second 37 C.F.R. section 1.131 declaration executed by said inventor, was filed (mailroom date June 7, 2004) for the purpose of swearing behind the said reference.
- 4. On July 15, 2004, in an interview in the United States Patent and Trademark Office, the Examiner agreed and noted in an Interview Summary, that "conception prior to the critical reference date under 37 CFR 1.131 was established."
- The documents filed in support of the above two 37 C.F.R. section 1.131 declarations, which were attached thereto, were obtained from the inventor Christian Mayaud.
- 6. Included in said documents was a copy of a page of Christian Mayaud's personal calendar dated January 12, 1993 and marked Exhibit B. In the second 37 C.F.R. Section 1.131 declaration (dated June 4, 2004), at page 3, Christian Mayaud stated:

In further support of the date of this said meeting, attached hereto as Exhibit B, document no. POL 05667, is a copy of two pages from my personal calendar. In my writing there is displayed on the left side a morning entry, showing my "9:30" meeting (third party name and meeting location redacted) which date, printed on my calendar (redacted), is prior to December 13, 1993. This corroborates the date on the handout and the date the meeting took place prior to December 13, 1993. Other writings on this Exhibit B sheet reflect my notes of the parties in attendance at the meeting.

- 7. For the purposes of supporting diligence in this matter, I requested Christian Mayaud, and he agreed, to provide and did provide copies of his personal calendar, that were still in his possession, including the period of time of December 13, 1993 to October 28, 1994. These documents included the above referenced page dated January 12, 1993 from his personal calendar. As Christian Mayaud declared in his June 7, 2004, 37 C.F.R. 1.131 declaration, the January 12, 1993 personal calendar page was in his handwriting and made by him at or about the time indicated on the date of each page. It is my belief these personal calendar documents contain facts from the inventor relating to his diligence in prosecuting his above captioned patent application that are true and accurate.
- 8. Outside patent counsel prosecuting the above matter for Andrx Corporation reviewed every entry from said personal calendar with the inventor, Christian Mayaud, which relevant parts were recorded in a "proposed" 37 C.F.R. 1.131 declaration, which said counsel reviewed with Christian Mayaud.
- 9. On October 14, 2004, in an interview in the United States Patent and Trademark Office, the Examiner agreed to review "proposed" third 37 C.F.R. section 1.131 declaration and noted in an Interview Summary, that the evidence submitted in the interview for diligence "does establish sufficient evidence for diligence for the time period of December 13, 1993 to October 28, 1994."
- 10. The evidence submitted in said October 14, 2004 interview, was the "proposed" 37 C.F.R. section 1.131 declaration with supporting documentation, the relevant copies of pages from Christian Mayaud's personal calendar for the period of time December 13, 1993 to October 28, 1994.

- 11. On or about January 30, 1995, the named inventor, Christian Mayaud, executed an Assignment of his rights in U.S. Patent Application Serial No. 08/330,745 (the parent application to the '681 Application) to MED-E-SYSTEMS Corporation. Andrx Corporation, by assignments, is the present owner of all rights to the '681 Application.
- 12. In said January 30, 1995 Assignment agreement, the inventor, Christian Mayaud, agreed to "execute any and all lawful documents and papers... to any continuation... of the application... in the assignee, its successor or assigns."
- 13. On behalf of Assignee, Cybear, LLC, I have made numerous attempts, but have been unable to obtain the signature of the inventor, Christian Mayaud, on the 37 C.F.R. section 1.131 declaration, submitted for diligence. Notwithstanding the obligation of the inventor, he is not cooperative and will not sign the 37 C.F.R.
 1.131 declaration for diligence.
- 14. This declaration is submitted in support of the Assignee, Cybear, LLC, executing the said proposed 37 C.F.R. 1.131 declaration for diligence on behalf of the inventor, in view of the fact the inventor is not cooperative and would not sign the said 37 C.F.R. 1.131 declaration.
- 15. On Monday, January 10, 2005 the undersigned, outside patent attorney Robert M. Schwartz, and Patent Agent David Barman an Andrx Corporation employee held a telephone conference with Examiner Rimmel of the above '681 application who agreed that in view of the non-cooperation of inventor, Christian Mayaud, the Assignee should submit a written statement explaining the facts that the inventor

was uncooperative and would not execute the 131 declaration and that the Assignee should execute the said 131 declaration on behalf of the said inventor.

DECLARATION

I, Ted W. Whitlock, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the united States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Ted W. Whitlock

Date: January 25, 2005





IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant

Christian MAYAUD

Serial No.

09/941,681

Filing Date

August 30, 2001

Title

A COMPUTERIZED PRESCRIPTION SYSTEM FOR

GATHERING AND PRESENTING INFORMATION

RELATING TO PHARMACEUTICALS

Examiner

Samuel G. Rimell

Group/Art Unit

2165

Commissioner for Patents Alexandria, VA 22313-1450

DECLARATION OF PRIOR INVENTION IN THE UNITED STATES OR IN A NAFTA OR WTO MEMBER COUNTRY TO OVERCOME A CITED PATENT OR PUBLICATION 37 C.F.R. § 1.131

I, Christian Mayaud, am the named inventor of the '681 Application.

The present '681 Application is a continuation of United States Patent Application serial number 09/121,597, filed July 24, 1998, which is a continuation of United States Patent Application serial number 08/942,372, filed October 2, 1997 (now U.S. Patent number 5,845,255), which is a continuation of U.S. Patent Application serial number 08/330,745 (the '745 Application) filed October 28, 1994 (now abandoned).

From at least a date prior to December 13, 1993, until the date my '681 Application was filed, I continuously worked on my invention, set forth in the '681 Application, by meeting with

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and communicating with my patent attorneys, who were drafting my application, as well as continuing the process of building apparatus and processes to carry out my inventions.

For many many years, it has been my practice to keep detailed notes of my daily activities, and schedules in a personal appointment book system. The appointment book system that I used had a separate notebook for each calendar month. Each notebook was bound with a spiral ring. It has further been my practice to keep these appointment books from year to year.

At the request of counsel I searched for and found my appointment books for the years 1993 and 1994. I recently reviewed these appointment books and searched for entries related to the filing of the '681 Application. Attached hereto are copies of these relevant pages from my personal appointment books. The entries in these appointment books were made by me contemporaneous with the dates indicated.

On a date prior to December 13, 1993, I retained a Patent Law Firm to file a patent application for my said inventions. From a date prior to December 13, 1993 and up to October 28, 1994 I continuously and regularly met and communicated with my patent attorneys who drafted my patent application. As a result of continuous and diligent meetings and communications with my patent attorneys, a patent application was drafted resulting in the '681 Application, which had 172 typewritten pages in the specification and 16 sheets of drawings. The '681 Application was filed with 69 claims which included three independent claims. In order to draft this application, considerable amount of time was necessary to meet and communicate with my patent attorneys and review each claim as well as to review the entire specification and the drawings and flow charts. The specification drafted by my patent attorneys included at least 35 separate sections detailing and describing my invention, which required the

numerous meetings and communications with my patent attorneys to draft. In addition, during this time, I met with vendors of products to determine if their products could be used in my system. I also met continuously with developers of my system.

At all times from a date prior to December 13, 1993 through the filing date of my '681 Application, both my patent attorneys and I were diligent in preparing and filing my '681 Application for patent.

I respectfully bring attention to the following entries, by date and in quotes below, in my appointment books, on the following dates, copies of these pages are the attachments hereto:

December 1, 1993. "call Tony Handal re patent application." Anthony Handal, was the patent attorney I retained to draft my patent application. He was with the firm of Handal & Morofsky, 80 Washington Street, Norwalk, CT 06854.

December 1993. "10AM Handal conference call." See block for December 27, 1993

January 5, 1994. "10AM Handal meeting re Patent," "Call Tony to confirm appt,"

"Handal discuss acronymous TM – discuss POL patents – copyright notice." POL was the acronym that I used in my appointment book and in other communications to designate my invention Physicians On Line, which is the subject of the '681 Application.

January 6, 1994. "Call Handal (1/5) re FAX [changes]" In this entry, my abbreviation for changes is a "delta" sign. The date in parenthesis is a reference to a prior entry, in this case the entry the day before.

January 7, 1994. "Handal meeting," "Handal meeting (1/6, 1/5)"

January 11, 1994. "11am aggregating/Hayes/TT" This is a reference to a meeting regarding use of prescriptions in a PDA (Personal Digital Assistant) with a director of the F.D.A., Hayes.

January 21, 1994. "Review Handal fax"

January 24, 1994. "Handal call back content overview Q & A screen"

February 8, 1994. "Called Susan Will...at USP... discussed Licensing options...need documentation from USP" USP is U.S. Pharmicapia, looking for data, listing of drugs

February 14, 1994. "Send/fax list of trademarks to Handal... Follow up with Susan Williams at USP... Follow up with USP Lawyer"

February 15, 1994. "Review Patent Claims and send to Handal for second cut"

February 21, 1994. "Call Beth re Vets Online"

February 25, 1994. "Call Tony Handal re Trademarks ... Fax lists"

February 28, 1994. "Call Tony Handal re Dentists/Vets/Pharmacists Online...physicians... Online Model"

March 2, 1994. "Handal Med-E-Vision...TM: Dentist Online, Pharmacists Online, Vets Online"

March 7, 1994. Review MEM patent claims, Review POL patent claims, call Greg re Patent Claims, review Desktop POL metaphor" MEM here refers to Med-E-Mail and a handheld PDA. Greg Fraley is the individual.

March 8, 1994. "Review Rx info...Rx interaction... Review interface with Bill... Send POL/MEM patent claim to Handal"

March 9, 1994. "USP Rx data... get POL claims from Cheryl, get POL claims from Bill" They reviewed the patent claims, both Officers at POL.

March 11, 1994. "Call Greg re Patent" Greg Fraley was in charge of programming development. His company was in Chicago. He was developing the programming for my invention/system.

March 14, 1994. "Write Patent overview statement"

March 24, 1994. "MEM Technical meeting/TT... Review Patent work with Handal (MEM)" MEM refers MediMail which was the subject of my invention. TT is Tarrey Town where meetings took place with Chicago personnel.

March 25, 1994. "9:30 Handal/Roger phone conference...review POL Patent claims...follow up with Greg re--...follow up FAX..." Roger refers to Roger Pitt at the Firm who assisted Tony Handal in drafting my patent application.

April 1, 1994. "Finish MEM business plan revisions" MEM included Smart Scripts.

April 13, 1994. "Apple Jane Curley" Jane Curley worked for Apple and was involved in the Newton project in California. Our system was disclosed to her on a confidential basis so that she could provide information to us regarding their development of the Newton PDA in order for us to evaluate use of that product in our system.

April 14, 1994. "Metricom" Metricom was a wireless provider, they were building a digital spectrum "Ricochet" which was a wireless carrier which we were exploring use of their services for our products.

April 15, 1994. "Call Handal re Med E Net Health Bank and ..." Later Med E Net became Physicians Prescribing Network.

April 18, 1994. "Follow up with Handal on Med E Net (Health Bench/E-Media)" Health Bench was a code name for our server providing directory services in the system.

April 21, 1994. "4pm Middleton meeting (4/21)... called Jane Curley" Middleton was Anderson Consulting, confidential discussions related to a pilot project was being explored regarding the implementation of E-Prescribing.

April 25, 1994. "7pm Apple/Curley/Brian/Newton CAP...call Jane Curley at Apple re Newton Develop Brian" Brian Dear was in San Diego and had developed a client server using a Unix system. Newton refers to Apple's PDA at issue was whether the Newton would work and talk to Brian's server. Curley brought in her technical people at this meeting.

April 27, 1994. "Follow up with Handal re Health Bank E-Media"

May 2, 1994. "Submit trademark application changes/Med E Net... call Handal re MES service mark...review MAC CAP development update strategy, call Apple, Jane Curley re support for MAP" MAC CAP refers to Macintosh Client Application Development.

May 3, 1994. "Test MAC CAP on _____ system"

May 7, 1994. "1-2pm Brian Salsburg/Metricom"

May 9, 1994. "Call Jane Curley re Newton and voicemail POL and MEM voicemail...Handal follow up... Handal POL-by physician for... MEM-the Point of Care Connection"

May 11, 1994. "Call Brian re Newton, MAC CAP, E-mail, ... Voicemail" Brian was our platform developer in Chicago and with the Newton we were determining whether the Newton platform was mature enough to work with our system. Everything was being developed simultaneously.

May 12, 1994. "Discuss Brian/Coconet with Steve Newton, WIN and MAC CAP...

Newton/\$/Apple" The name of our platform was Coconet using COCO TALK, which stood for Community Communications Network, today that would be considered the html language which did not exist at that time.

May 18, 1994. "Follow up with Handal re service mark (5/9)... Follow up with Handal re Health Bank E Media"

May 20, 1994. "Follow up with Handal"

May 23, 1994. "Handal Veterinary Online, Pharmacists Online" These were for online services for Vets and Pharmacists to use and interact with our system.

May 27, 1994. "Handal re Med E Mail" Med E Mail was E-prescription system.

May 30, 1994. "Review Med E Mail response"

May 31, 1994. "Handal re MediMedia (triple i)" Triple i Pads were prescription pads given to doctors. We were looking for a way to incorporate advertising into the pads and also trying to figure out if we could draft a patent claim to that.

June 1, 1994. "Outline Personal Prescribing Center with Paul... Handal, Health Bench, E Media, Pharmacists Online, Vets Online, re service mark (5/9)" The personal prescribing center was the patient side of Smart Scripts, personal prescribing, described in the invention. We were raising issues how to confirm or authenticate the doctor's use of the DEA number on the E Prescription.

June 6, 1994. "Med-E-Care/Med-E-Media with Handal"

June 9, 1994. "Handal MES patent (5/9), POL service...Health Bank... Pharmacists Online, Vets Online"

June 13, 1994. "Review...with Handal and Patents (5/9, 6/9)"

June 14, 1994. "Call Motorola re group ATP...Finalize MES DBA...Handal-Med-E" ATP was Motorola's Advance Technology Program we were using for prescriptions. At this time we were finalizing the Medi System data base architecture.

June 17, 1994. "10 Handal phone conference, Handal conference call, Handal phone conference..., review trademark status, review patent status, (6/9) (5/9), "Med-E" strategy Vets Pharmaceutical"

June 21, 1994. "4pm Handal conference call... Handal conference call"

June 22, 1994. "Call Motorola Group re: ATP," exploring whether we could use in our system the ATP and the Motorola "Envoy" handheld wireless for prescriptions.

June 23, 1994. "Call J. Curley at Apple Re: Newton CAP"

June 29, 1994. "Call Handal Re: Trademark modification...call Handal re: CM3"

June 30, 1994. "MES 1. Health Bank, 2. New screen shots, 3. patent review, 4. get screen photos with JE preferred, demo scenarios" Health Bank referrers to the server for the prototype, JE was John Edelson.

July 5, 1994. "Call IMS re: personal prescribing profiles, call Motorola re: ATP...finish CM3 drafts review" IMS is a company that owns prescription data. IMS aggregates the data to help pharmaceutical industry to analyze information including prescriptions, drugs and doctors. This IMS information was used to make Smart Scripts work and to prepopulate the server with information.

July 6, 1994. Call Handal re: trademark modifications...call Handal re: MES patent review CM3"...call Joanne Tamm for smart script screen shots...call Handal re: Primedia"

July 7, 1994. "Arrange Health Bench... at MES... arrange new interface review"

July 12, 1994. "Schedule patent review, finish CM3 draft review"

July 13, 1994. "Follow up with Greg re: HOST...call Patent Attorney" the above mentioned re: HOST referred to arrange Federal funding

July 17, 1994. "Review patent application"

July 20, 1994. "9:30 Handal meeting/Review Patent Application"

July 26, 1994. "Call IMS re: PPP" PPP stands for Physician's Personal Prescribing Profile

July 27, 1994. "Follow up MediMail Response...arrange MES/Chicago meeting with DBA re: H/B...call Scott Cleary at Anderson" MediMail response is another acronym for the system, the MediSystems was referring to a Chicago meeting with our developers regarding the database and Scott Cleary at Anderson Consulting was a possible partner for the Smart Script system.

August 1, 1994. "11am interview with Wired" Wired was a publication/magazine and the published interview was on virtual patient records and E-prescriptions

August 3, 1994. "Call wired reporter"

August 11, 1994. "Follow up with Handal re: patent...call Scott Cleary at Anderson"

August 15, 1994. "Review ATP with Jon and Steve...follow up with Handal re:

Patent...re: MediMail response... call IMS re: PPP...call Brian re: MACCAP...Finish

ATP memo for Steve/Jon" ATP was a file transfer protocol with Motorola being

developed and explored for the POL system.

August 17, 1994. "Call Motorola/Phoenix Group... call Phil _____... follow up with Handal re: Patent/MediMail response promedia/pro onlines" Phil was approached regarding an alternate drug database.

August 19, 1994. "Follow up with Handal re: Patent...follow up with Adam Lambda re: Patent" Adam Lambda is another patent attorney that had experience in drafting software patents and had been contacted as a back up to Handal who I thought had not done a software patent previously.

August 25, 1994. "Follow up re: MES patent" MES stands for Medi Systems.

August 29, 1994. "Follow up with Roger re: Patent, follow up with Handal re: TM's"

September 1, 1994. "Call Handal patents"

September 2, 1994. "Call Handal re: E-Media Med-E-Media"

September 5, 1994. "Arrange Chicago MES trip for Wed/Thurs...Tamm" Tamm is a code word for interfaces used in the system being developed in Chicago.

September 9, 1994. "Call Scott Cleary at Anderson, follow up with Greg re HOST... call Motorola/Phoenix Group... follow up with Brian/Jon on FAX printer...call Tony re

confidentiality..." References above to Greg were obtaining documents from Motorola in regards to their protocol, references to FAX printer was regarding faxing of prescriptions and sending the fax to a printer. The reference to Tony is Dr. Tony Kotin who was being consulted in regards to liability issues on the server side. At this time there was no HIPPA regulations which we were anticipating and Tony's expertise was in this area.

September 13, 1994. "Call Tony Handal, E-Media, Med E-Media, Promedia"

September 15, 1994. "Follow up Tony Kotin, confidentiality"

September 16, 1994. "Fax Med E-mail use statement to Handal"

September 18, 1994. "Finish Patent Review"

September 19, 1994. "Incorporate Patent revisions...finish Patent Review"

September 20, 1994. "Call Tony re: confidentiality spokesman...Greg Frailey follow up with Jane Curley" Tony Kotin,

September 29, 1994. "Follow up with Scott Clearly at Anderson, follow up with Greg re: HOST, call Motorola re: Phoenix Group" All actions related to development of the POL system.

September 30, 1994. "9:30 Handal/Roger appointment" My Patent Attorneys.

October 7, 1994. "Review Patent application with Roger, call Brian re: Apple with Newton CAP"

October 8, 1994. "Review Patent application"

October 10, 1994. "Finish patent review, call Jane Curley with Steve... call Roger with corrections/Patent"

October 11, 1994. "Call Handal re WHIN Trademark... call Jane Curley with Steve"

October 12, 1994. "Finish Patent work"

October 13, 1994. "8:30 Roger meeting at Handal/Norwalk"

October 14, 1994. "Review Trademarks"

October 17, 1994. "Follow up with Roger re MES Patent App"

October 18, 1994. "Review trademarks, outline MEM/SPD... review Domain Names..."

October 20, 1994. "Order Apple Human Interface Design Guide... follow up with Jane Curley"

October 21, 1994. "Call Roger with Revisions... Fax new to Roger"

October 24, 1994. "10am call Handal/Roger for Final Review... Finalize Patent App...review all TM activity"

October 25, 1994. "Review Final Patent changes...Review all TM activity"

October 26, 1994. "Call Handal re: TM's/Patent work"

October 27, 1994. "Call Roger re: patent deadline Tony inventorship ... Inventor – contributed materially to the inventiveness of the product ... the particular manifestation of the invention". On this date, a discussion with Tony Handal, took place in regards to the inventorship by Jonathan Edelson. It was decided that a separate application would be filed, substantially identical to the above captioned application but containing claims that were co-invented. There was no delay in filing the above captioned application

because of filing the second application (serial no. 330,939), both said applications were filed on the following date October 28, 1994.

DECLARATION

I, Christian Mayaud, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the united States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: January 25, 2005

Christian Mayaud

2 Governors Road

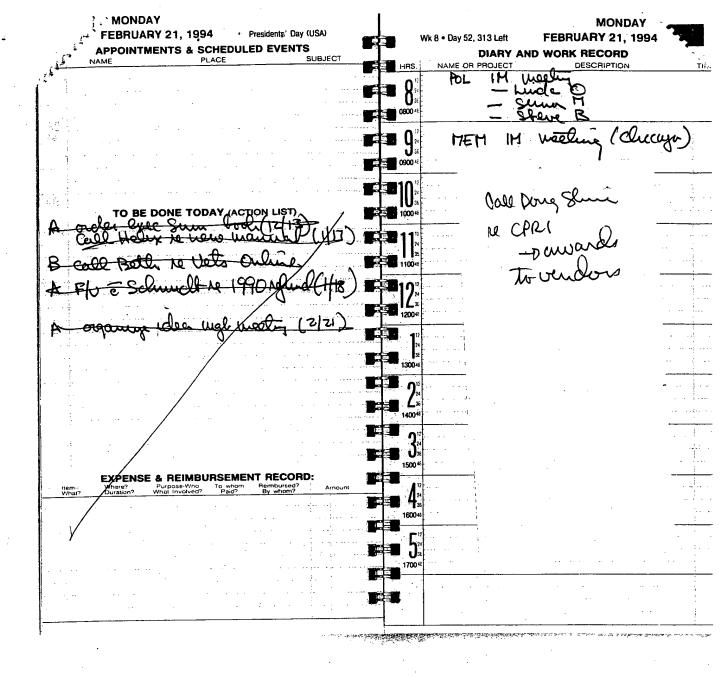
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By: Ted. W. Whitlock, on behalf of Christian Mayaud, Authorized Signatory of Assignee, CYBEAR, LLC.

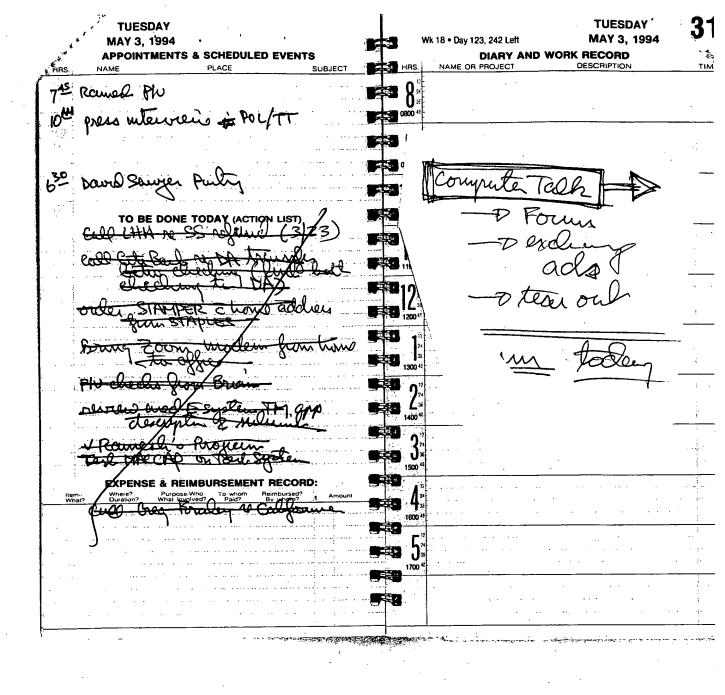
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MONDAY MONDAY **FEBRUARY 14, 1994** Wk 7 • Day 45, 320 Left FEBRUARY 14, 1994 APPOINTMENTS & SCHEDULED EVENTS

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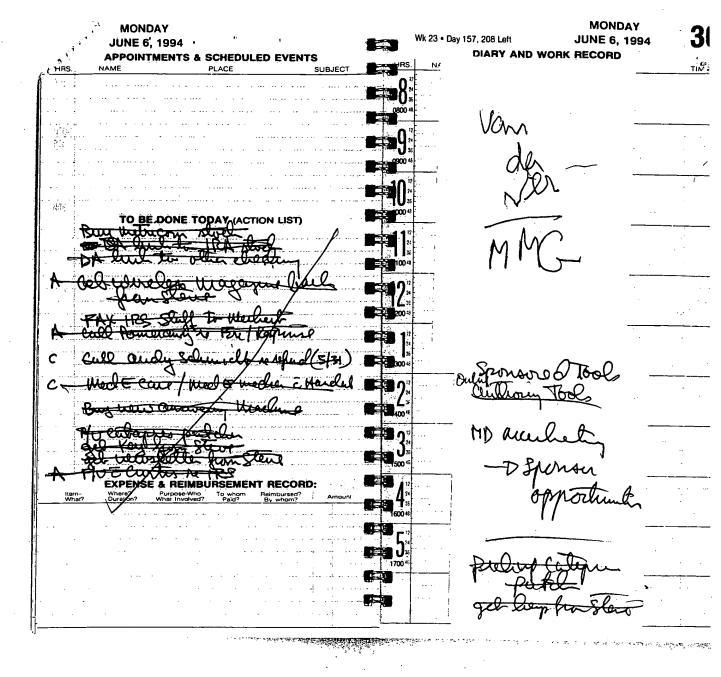


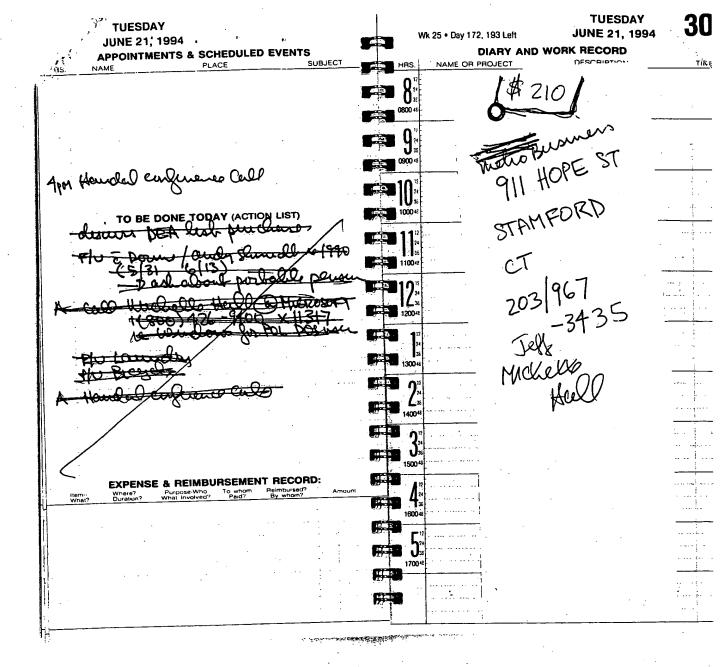
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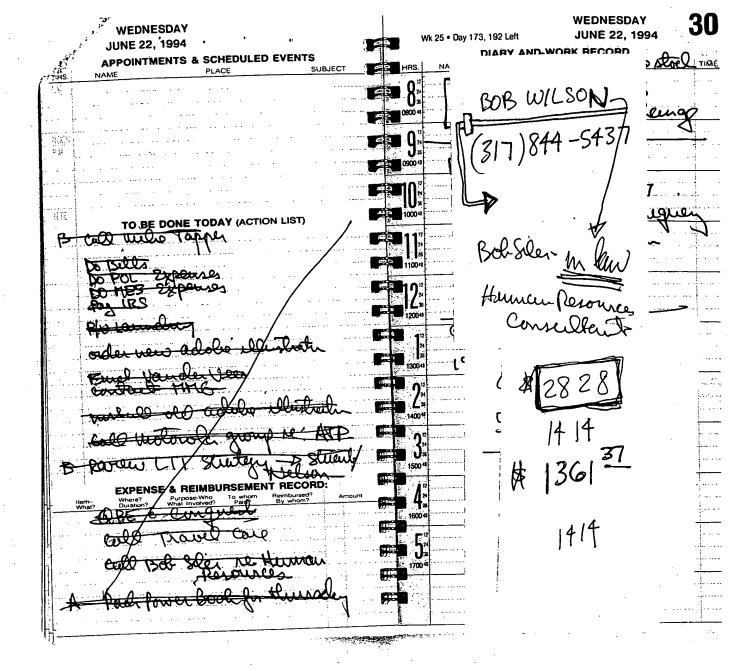


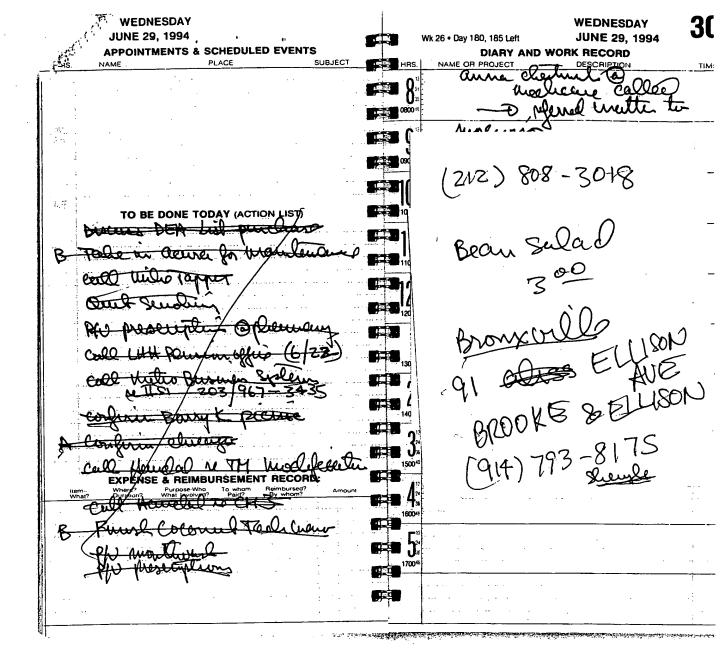
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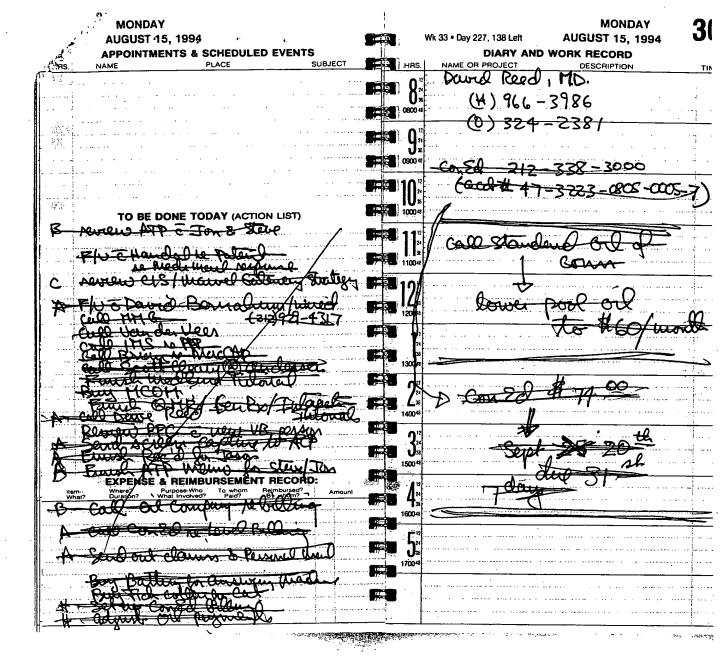
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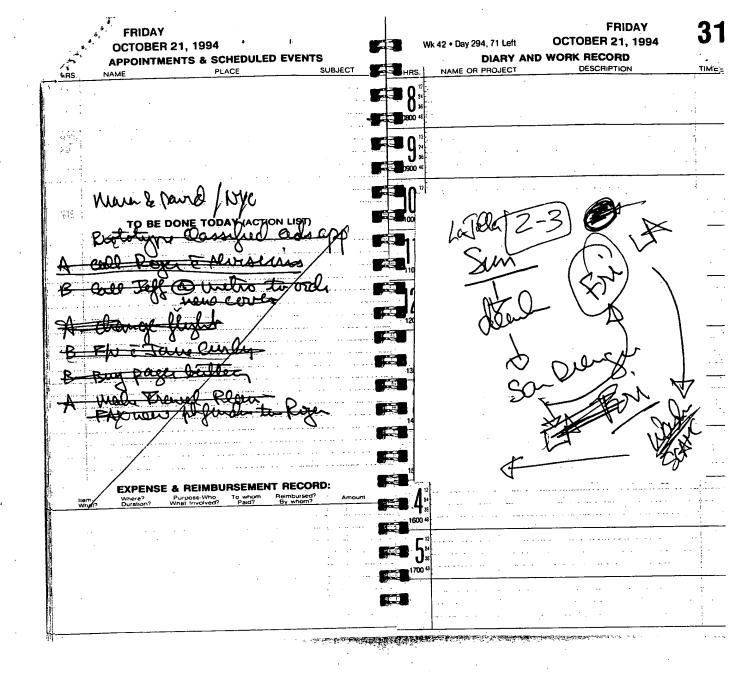








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